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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
097138,459	08/21/98	ROSEN	S 0225-4161US1

MORGAN & FINNEGAN
345 PARK AVENUE
NEW YORK NY 10154

LM02/0802

EXAMINER

TUCKER, C

ART UNIT

PAPER NUMBER

2766

DATE MAILED:

08/02/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/138,459

Applicant(s)

ROSEN, SHOLOM S.

Examiner

Christopher M. Tucker

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 12-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) ____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.

- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 12-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 36-37 and 45 of U.S. Patent No. 5,557,518. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference is that claims 12 and 17 of the instant application recites that the electronic transaction apparatus stores data from a second transaction device describing items purchased which would have been obvious for later auditing purposes.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 12-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Hayashida (U.S. 6,003,767).

5. As per claim 17, Hayashida discloses an electronic purchase transaction method, comprising the steps of:

sending electronic money from a first transaction device to a second transaction device during purchase transactions (column 2, lines 16-32; column 5, lines 57-62; column 6, lines 21-54);

storing in said first transaction device electronic money transfer data during said purchase transactions (column 6, lines 21-54; columns 7-9);

storing in said first transaction device data from said second transaction device describing items purchased (columns 7-9).

6. Claim 12 is the apparatus version of claim 17's method claim and is thus rejected under the same grounds.

7. As per claim 13, Hayashida discloses analyzing a list of purchases from said second electronic unit at a time after said purchase transaction (columns 7-8).

8. As per claim 14, Hayashida discloses that said second electronic unit connects to an accounts payable system (fig. 1 and associated text, especially column 2, line 65 – column 4, line 23).

9. As per claim 15, Hayashida discloses that said second electronic unit connects to a purchase order system (fig. 1 and associated text, especially column 2, line 65 – column 4, line 23).

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10. As per claim 16, Hayashida discloses that said first electronic unit is a money module and said second electronic unit is a trusted agent (fig. 1 and associated text, especially column 2, line 65 – column 3, line 55).

11. As per claim 18, Hayshida discloses that the data describing items purchased includes ticket data (column 2, lines 1-5; column 19, lines 19-48).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Tucker whose telephone number is 703 306 5539. The examiner can normally be reached on M-F between the hours of 8:30 and 4:30 with alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gail O. Hayes can be reached on 703 305 9711. The fax phone numbers for the organization where this application or proceeding is assigned are 703 305 0040 for regular communications and 703 305 0040 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305 3900.

CMT
CMT
July 30, 2000



GAIL O. HAYES
SUPERVISORY PATENT EXAMINER
GROUP 2700